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PHILIPS LUMILEDS LIGHTING COMPANY, LLC

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

17 EPISTAR CORPORATION,
18 Plaintiff,
19
20 v.
21 PHILIPS LUMILEDS LIGHTING
22 COMPANY, LLC,
23 Defendant.

Case No. C 07-5194 CW

**PHILIPS LUMILEDS LIGHTING
COMPANY, LLC'S NOTICE OF MOTION
AND MOTION TO CONTINUE THE
INITIAL CASE MANAGEMENT
CONFERENCE**

AND RELATED COUNTERCLAIMS

1 TO EPISTAR CORPORATION AND ITS COUNSEL OF RECORD:

2 PLEASE TAKE NOTICE that, pursuant to Local Rule 6-1 and 6-3, defendant and
 3 counterclaimant Philips Lumileds Lighting Company, LLC (“Lumileds”) hereby requests that the
 4 Court continue the initial case management conference currently scheduled for February 12, 2008
 5 to April 1, 2008 at 2:00 p.m.

6 **I. INTRODUCTION**

7 In the interest of efficiency and judicial economy, Lumileds requests that the Court
 8 continue the Case Management Conference and related deadlines in this case until after resolution
 9 of a motion to stay that Lumileds has noticed for the next available hearing date (March 6, 2008).
 10 This Court has recently ruled that the present case is related to an earlier-filed patent case due to
 11 overlapping factual and legal issues. That patent case is currently stayed, because it is a
 12 companion to a case brought in the International Trade Commission that is currently on appeal.
 13 Accordingly, Lumileds intends to move to stay the present case until the stay on the related patent
 14 case is lifted. Since the case management conference, case management statement, and related
 15 meet and confer will be dramatically impacted by whether the Court stays the case, it will be far
 16 more efficient to extend the deadlines for those activities until after resolution of Lumileds’
 17 motion to stay.

18 **II. BACKGROUND**

19 On November 4, 2005, Lumileds filed a patent infringement suit before this Court against
 20 United Epitaxy Co. (“UEC”) and Epistar Corporation.¹ *See Lumileds Lighting U.S., LLC v.*
 21 *Epistar Corp. & United Epitaxy Co., Ltd.*, Case No. 05-4521 CW (filed Nov. 4, 2005)
 22 (“Lumileds/Epistar 2005 litigation”). UEC and Epistar moved to stay the district court action
 23 pending the outcome of a related investigation being conducted by the United States International
 24 Trade Commission (“ITC”), titled *In the Matter of Certain High-Brightness Light Emitting*
 25 *Diodes and Products Containing Same*, Inv. No. 337-TA-556, pursuant to 28 U.S.C. § 1659.²

26 ¹ Epistar and UEC merged, effective December 31, 2005.

27 ² Upon the request of any party to a civil action who is also a respondent in an ITC investigation,
 28 the Court “shall stay, until determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding

1 The Honorable Ronald M. Whyte of this Court granted the motion and the case remains stayed to
 2 this day. In May 2007, the ITC issued a final determination in favor of Lumileds, finding, among
 3 other things, that Epistar's products infringe Lumileds' '718 patent. The ITC issued an exclusion
 4 order barring importation of the infringing products as well as certain downstream products.
 5 Epistar is currently appealing the ITC's decision to the United States Court of Appeals for the
 6 Federal Circuit.

7 On October 10, 2007, Epistar brought the current action titled *Epistar v. Philips Lumileds*,
 8 Case No. 07-5194 CW ("Lumileds/Epistar 2007 Litigation"). On December 17, 2007, this Court
 9 issued an order deeming the Lumileds/Epistar 2005 Litigation and the Lumileds/Epistar 2007
 10 Litigation to be related to earlier filed actions between the parties and ordered that both cases be
 11 reassigned to the Honorable Claudia Wilken. Three days later, the Court issued a Case
 12 Management Scheduling Order for the reassigned cases and set an initial case management
 13 conference on calendar for February 12, 2008.³

14 **III. RELIEF REQUESTED**

15 Lumileds requests that the Court continue the initial case management conference from
 16 February 12, 2008 to April 1, 2008 or until after this Court rules on Lumileds' motion to stay the
 17 Lumileds/Epistar 2007 Litigation, which is noticed for hearing on March 6, 2008. Lumileds also
 18 requests that the requirements set forth in Federal Rule of Civil Procedure 26 and Local Civil
 19 Rule 16 be continued accordingly.

20 **IV. CONTINUING THE CASE MANAGEMENT CONFERENCE WILL PRESERVE**
 21 **COURT AND PARTY RESOURCES**

22 A brief continuance of the recently scheduled initial case management conference will
 23 promote judicial economy and will preserve party resources. Filed concurrently with this
 24 administrative motion is Lumileds' notice of motion to stay the Lumileds/Epistar 2007 Litigation.
 25 As Lumileds will demonstrate in its motion to stay, a stay of this litigation pending the resolution
 26 before the Commission." 28 U.S.C. § 1659.

27 ³ As discussed above, all proceedings in the Lumileds/Epistar 2005 Litigation have been stayed
 28 pending the final resolution of the ITC proceedings, including the current Federal Circuit appeal,
 pursuant to 28 U.S.C. § 1659. Accordingly only the Lumileds/Epistar 2007 Litigation would be
 the subject of the upcoming initial case management conference.

1 of a related International Trade Commission (“ITC”) investigation will conserve judicial
 2 resources, will avoid duplicative, piecemeal litigation, and will avoid potentially conflicting
 3 decisions. Lumileds has requested that the hearing on its motion to stay be conducted on March
 4 6, 2008 – this Court’s first available civil law and motion hearing date – or as soon thereafter as
 5 the Court’s calendar allows. This hearing date unfortunately falls after the February 12, 2008
 6 initial case management conference date. The simple solution is a slight revision to the current
 7 case management scheduling order to accommodate the Court’s crowded docket while at the
 8 same time conserving the Court’s and the parties’ resources.

9 Under the current case management schedule, the parties will be required to expend
 10 considerable time and effort (1) to meet and confer and agree on a discovery plan, (2) to exchange
 11 initial disclosures, and (3) to prepare a joint case management statement, before the briefing on
 12 Lumileds’ motion to stay is completed. In addition, the case management conference itself will
 13 require the time of both the parties and the Court. Many, if not all, of the decisions reached in
 14 advance of and during the case management conference will be rendered moot if the Court grants
 15 Lumileds’ motion to stay the Lumileds/Epistar 2007 Litigation. Moreover, these activities will be
 16 dramatically affected if the Lumileds/Epistar 2007 Litigation is not litigated until the stay is lifted
 17 in the Lumileds/Epistar 2005 litigation (such that both cases are litigated together). The resources
 18 and the time involved will be better invested once the Court has determined whether the case will
 19 proceed or will be stayed along with the companion Lumileds/Epistar 2005 Litigation. A brief
 20 continuance of the initial case management conference will not prejudice either party; rather it
 21 will allow the parties to fully brief Lumileds’ motion to stay and will allow this Court to resolve
 22 this important threshold issue before engaging in potentially unnecessary proceedings.

23 **V. PRIOR EFFORTS TO OBTAIN A STIPULATION**

24 Lumileds’ counsel contacted Epistar’s counsel on January 9, 2008, and proposed that the
 25 parties stipulate pursuant to Civil Local Rule 6-2 to a brief continuance of the initial case
 26 management conference to allow for briefing on Lumileds’ anticipated motion to stay the
 27 proceedings. (Declaration of Andrew J. Wu (“Wu Decl.”) at ¶ 2.) On January 11, 2008,
 28 Epistar’s counsel responded and stated that it saw “no reason or basis to continue the CMC”

1 despite being aware that Lumileds planned to move to stay the present case. (Wu Decl. at ¶ 3.)

2 Accordingly, Lumileds was forced to bring this motion.

3 **VI. PRIOR TIME MODIFICATIONS**

4 When Epistar filed its complaint, the Court assigned the case to the Judge Fogel and
 5 issued an order setting the initial case management conference on February 1, 2008. On
 6 December 17, 2007, Judge Wilken deemed the case related to others assigned to her and ordered
 7 it reassigned to her. Judge Wilken issued a case management scheduling order for the newly
 8 reassigned case and reset the initial case management conference to February 12, 2008. No other
 9 scheduling modifications have been requested or made.

10 **VII. EFFECT UPON THE SCHEDULE FOR THE CASE**

11 The Court has not yet issued a scheduling order in this case. Therefore, only the case
 12 management conference itself is affected by this motion to continue the case management
 13 conference; no other dates will be affected.

14 **VIII. CONCLUSION**

15 Lumileds respectfully requests that the Court continue the initial case management
 16 conference from February 12, 2008 to April 1, 2008 or until after this Court rules on Lumileds'
 17 motion to stay the Lumileds/Epistar 2007 Litigation noticed for hearing on March 6, 2008.
 18 Lumileds also requests that the requirements set forth in Federal Rule of Civil Procedure 26 and
 19 Local Civil Rule 16 be continued accordingly.

20 Dated: January 18, 2008

21 MORGAN, LEWIS & BOCKIUS LLP

22 By /s/ Michael J. Lyons

23 Michael J. Lyons
 24 Attorneys for Defendant and
 Counterclaimant
 25 PHILIPS LUMILEDS LIGHTING
 COMPANY, LLC